APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF PATENT APPEALS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of) Richard C. JOHNSON) For: **eDROPSHIP: METHODS AND** **SYSTEMS FOR ANONYMOUS** **eCOMMERCE SHIPMENT** Serial No.: 09/490,783 Filed: January 24, 2000 Atty. Docket No.: ORCL5628	Examiner: Christopher L. GILLIGAN Art Unit: 3626 Confirmation No.: 7640 Customer No.: 53156 **BRIEF IN REPLY TO SECOND** **EXAMINER'S ANSWER OF 12/9/08**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is timely filed responsive to the Second Examiner's Answer mailed December 09, 2008.

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Status of Claims

The claims are not amended herewith.

Accordingly, the claims stand unchanged as they were presented in the Appeal Brief dated September 20, 2007.

It is, therefore, respectfully requested that the present Appeal be maintained.

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Grounds of Rejections To Be Reviewed On Appeal

The grounds of rejection to be reviewed on appeal are as follows:

1. Whether claims 1-4, 7-10 and 13-16 are unpatentable under 35 USC § 103(a) over Shub et al. in view of Kadaba, and

2. Whether claims 1, 7 and 13 are directed to non-statutory subject matter under § 101 as allegedly failing the Office's "machine-or-transformation" test.

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<u>Arguments</u>

The previously-filed Appeal and Reply Briefs adequately set out the applicant's arguments regarding the outstanding §103(a) rejections.

It is noted that the Examiner entered new grounds for rejection in the Examiner' Second Answer, which was entered <u>after</u> the Examiner's first Answer of December 13, 2007, <u>after</u> the applicant's Reply Brief of February 4, 2008, <u>after</u> the Examiner's Response to Reply Brief of April 11, 2008 and even <u>after</u> the matter had been sent to the Board on July 7, 2008.

At this late stage, the Office made the Examiner's Answer "in response to the appeal brief of 9/20/2007 appealing from the Office action mailed 4/06/2007", when the time period for such Examiner's Answer had clearly passed. As stated in the Office's own guidelines in the MPEP:

1207.02 Contents of Examiner's Answer< [R-3]

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

It is respectfully submitted, therefore, that the Examiner's Answer of 12/9/08 should be set aside by the Board as being untimely, as would any Appeal Brief submitted by the Applicant long after the allowed period for such had passed. Respectfully, there can be no parity between the Office and an applicant when the Office is allowed to circumvent the established rules of the game while the applicant is bound by those very same rules.

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At best, the Examiner's Answer of 12/9/08 should be considered to be a "**Supplemental Examiner's Answer**", in which new grounds for rejection are <u>not</u> permitted, as again noted in the MPEP:

> **A supplemental examiner's answer cannot include a new ground of rejection, except when a supplemental answer is written in response to a remand by the Board for further consideration of a rejection under 37 CFR <u>41.50</u>(a). See MPEP § <u>1207.05</u>.**

No such remand by the Board appears to be of record in this case, and the Examiner's Answer of 12/9/09 should be dismissed as being untimely and against both the implementing regulations and the Office's own guidelines.

The above notwithstanding, the following arguments address the newly applied §101 rejections of the claims.

The applicant respectfully traverses the §101 rejections and, therefore, respectfully requests that the Board reconsider and reverse the 35 USC §101 rejections of the pending claims.

Claim 1 recites

> 1. (Previously Presented) A method for a bank to enable anonymous shipment by a shipper of a package containing goods purchased by a customer from a vendor for delivery to an address unknown to the vendor, the customer maintaining an account at the bank, the bank storing an address associated with the customer's account, the method comprising the steps of:
>
> the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;
>
> the bank authenticating the customer and guaranteeing payment to the vendor on the draft only if the customer is authenticated and bank-imposed restrictions are met;
>
> if the customer is authenticated and bank-imposed restrictions are met,

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the bank generating the requested package code, the package
code being devoid of delivery address information;

the bank sending the generated package code to the vendor,
wherein the bank does not send any delivery address information
for the package to the vendor; and

the bank generating a shipping identifier for the package that
is associated with the generated package code and retrieving the
stored address associated with the customer's account, and

the bank sending the generated shipping identifier and the
retrieved address associated with the customer's account at the
bank to the shipper to enable the shipper, after picking up the
package for shipment from the vendor, to associate the package
code sent to the vendor with the shipping identifier, to identify the
associated address as the delivery address of the package, and to
ship the package directly from the vendor to the delivery address
without divulging any delivery address for the package to the
vendor.

The bank, as recited in claim 1, receives an <u>electronic draft</u> from the customer. Common

sense implies that the receipt of an electronic draft from a customer entails both a machine to

receive the electronic transaction and a transformation of the received electronic transaction by

way of the claimed authentication of the customer identified in the electronic draft and the

guaranteeing of the payment to the customer in response to receipt of said electronic draft. The

bank, thereafter, is claimed to generate a request package code and to send to generated package

code to the vendor, which also calls for machines (e.g., computers) to generate and send the

package code to the vendor over a computer network, as set forth in the specification. The same,

it is respectfully submitted, holds true for the bank-generated shipping identifier and the sending

thereof to the shipper, as also claimed herein. The receiving, generating and sending steps,

therefore, clearly set out the requisite machine-or-transformation steps now required by the

Office. It is respectfully submitted therefore, that the newly-imposed requirements for machine-

transformation steps in the body of claim are indeed satisfied.

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Claim 7 recites:

> **7. (Previously Presented)** A method for a shipper to process a package identified by a package code devoid of delivery address information, the package containing goods purchased by a customer from a vendor for shipment to an address unknown to the vendor, the method comprising the sequential steps of:
>
> the shipper receiving a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto but no delivery address;
>
> the shipper receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account, the delivery address being associated with the customer's account at the bank;
>
> the shipper picking up the package from the vendor;
>
> the shipper reading the package code affixed to the package;
>
> the shipper matching the package code with the received shipping identifier, and
>
> the shipper delivering the package from the vendor directly to the delivery address associated with the shipping identifier.

In this case, the recited package is claimed to have "a machine-readable package code affixed thereto", which the shipper is later required to read (4th claimed step). The reading of a machine-readable code clearly, therefore, constitutes a transformation (from a machine-perceptible representation of a code to a read code) sufficient to render this claim patentable under §101, especially as the read machine-readable code is then matched with a received shipping identifier. Moreover, the reading of a machine-readable code clearly ties this claim to a statutory category; namely, a machine configured to read machine-readable codes. It is respectfully submitted therefore, that claim 7 defines patentable subject matter under §101.

Lastly, claim 13 recites:

> **13. (Previously Presented)** A method for a vendor to cause a

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package of goods purchased by a customer to be delivered to a delivery address that is unknown to the vendor, the method comprising the steps of:

the vendor sending a request for a package code to a bank at which the customer maintains an account and an electronic draft for payment of the goods on behalf of the customer;

the vendor receiving payment on the draft and the package code from the bank only if the customer is authenticated by the bank and bank-imposed constraints are satisfied, the package code being devoid of delivery address information;

the vendor preparing the package for shipment by the shipper such that the prepared package bears no delivery address information thereon;

the vendor affixing the received package code to the prepared package, and

the vendor surrendering the package to a shipper to enable the shipper to match the package code with a shipping identifier and the delivery address that were previously received by the shipper from the bank, to generate a shipping label specifying the delivery address, to affix the shipping label to the package and to ship the package directly from the vendor to the delivery address without divulging any delivery address to the vendor.
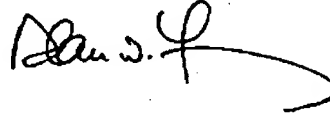
In this case, the vendor is recited to send an electronic draft to the bank, along with a request for a package code. Such a sending step to send an electronic draft to a bank, of course, requires a both a machine (e.g., a computer) and a transformation (such as, for example, the transformations necessary to format and send the electronic draft over a computer network, as set forth in the specification). In this case also, it is apparent that the package code is received from the bank in electronic form, in a manner similar to the manner in which the request therefor was sent to the bank: using computers to send messages in electronic form over a computer network. Any other interpretation, it is respectfully submitted, strains the plain meaning of the language of the claim.

It is respectfully requested, therefore, that the Board dismiss the late-stage §101 rejections as untimely and contrary to the rules and guidelines and/or reverse the §101 rejections,

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based at least upon the arguments herein.

A decision from the Board relative to the outstanding substantive final rejections of the pending claims under §103(a) is also respectfully requested.

Respectfully submitted,

Date:___February 9, 2009_____   By:_____

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